

REMARKS

In the Office Action, the Examiner rejected claims 1-50. By the present response, Applicant amended claims 1, 21, 37 and 46. In light of the foregoing amendments and the following remarks, reconsideration and allowance of all pending claims 1-50 are respectfully requested.

I. Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-18, 20-32, 34-42 and 44-50 under 35 U.S.C. § 102(b) as being anticipated by the Wehr reference (German Pat. No. DE/29,616,175U). Applicant respectfully asserts that the pending claims are patentable over the Wehr reference for at least two reasons. First, the Wehr reference is a German language reference that has not been translated for proper use in the Examiner's rejection. Secondly, the instant claims recite features not disclosed by the Wehr reference. In light of the following remarks, reconsideration and allowance are respectfully requested.

a. The Wehr Reference Must Be Translated

The Examiner has improperly applied the Wehr reference as support for his rejection. In the rejection, it appears that the Examiner relied on the abstract of the Wehr reference. However, "citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art." M.P.E.P. § 706.02, p. 700-20 (quoting *Ex parte Jones*, 62 U.S.P.Q.2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished)). To determine whether both the abstract and the underlying document are

prior art, a copy of the underlying document must be obtained and analyzed. M.P.E.P. § 706.02, p. 700-20. If the document is in a language other than English, and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. *Id.* Indeed, the underlying document may contain any number of facts or statements that contradict or clarify the statements in the translated abstract.

Accordingly, if the Examiner wishes to employ the Wehr reference as prior art against the instant application, Applicant respectfully requests that the Examiner provide an English translation of the Wehr reference and cite specific passages of the translated reference in support of the Examiner's rejection.

b. Claimed Features Omitted from the Wehr Reference

A *prima facie* case of anticipation under 35 U.S.C. Section 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). As discussed below, each independent claim recites features omitted from the Wehr reference.

1. Amended Independent Claim 1 and the Claims Depending Therefrom

As amended, independent claim 1 recites, *inter alia*, "a personal computer having a housing configured for a display...[and] a wall mount structure configured to mount the

housing on a substantially vertical surface.” Among other things, the Wehr reference does not disclose a *personal computer*, as recited in the instant claim.

During examination, a claim must be interpreted as broadly as their terms reasonably allow M.P.E.P. § 2111.01, p. 2100-47. That is, the words of a claim must be given their plain meaning unless the underlying specification has provided a clear definition. *See In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Moreover, the broadest reasonable interpretation must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999). Accordingly, the recited feature, “a personal computer,” must be given its plain meaning and read in a light consistent with the Application’s specification.

A personal computer may be defined as, “a computer based on a microprocessor central processing unit (CPU) intended for *personal use in the home or office*.” MCGRAW-HILL ELECTRONICS DICTIONARY 334 (6th ed. 1997). (Emphasis added). This definition is consistent with the exemplary computer system 10 described in the present Application. Accordingly, if the Examiner is to present a reference that anticipates the recited “personal computer,” such reference must disclose a device consistent with the foregoing definition. The disclosed device must present the appropriate *personal computer* architecture and design for *personal use in a home or office*.

In view of the present application and the foregoing definition, Applicant asserts that the Wehr reference does not disclose a personal computer, as recited in the instant claim. Rather, the Wehr reference discloses an "electronic advertising display device." *See Wehr, Title and Basic-Abstract.* The disclosed advertising display device merely "depicts static and/or dynamic images and/or text which are preferably constructed as files on a *separate* computer system." *Id.* However, based on the limited disclosure of the Wehr reference's abstract, the advertising display device itself is NOT a *computer system*, but rather the advertising display device requires the use of a *separate* computer system for its setup. Accordingly, there is no reason to believe that the advertising display device of the Wehr reference is a personal computer, as recited in the instant claim. In contrast to a personal computer, the advertising display device has no applicability for *personal use in a home or office*. Therefore, one of ordinary skill in the art would not consider the device of Wehr a personal computer.

In view of the foregoing omitted claim feature, Applicant respectfully asserts that independent claim 1 and its respective dependent claims 2-20 are patentable over the Wehr reference. Reconsideration and allowance of the present claims are respectfully requested.

**2. Amended Independent Claims 21, 37 and 46,
and the Claims Depending Therefrom**

Each of the remaining independent claims 21, 37 and 46 recites, in a general sense, *a personal computer*. More specifically, each of the foregoing claims recites as follows:

Claim 21: “*a personal computer*, comprising a housing;”

Claim 37: “*a personal computer* having a computer enclosure;” and

Claim 46: “thereby forming *a personal computer*.”

As discussed above, the Wehr reference does not disclose a *personal computer*, as recited in the instant claims.

Again, the term *personal computer* has a specific meaning to one of ordinary skill in the art. As discussed above, a personal computer may be defined as a computer intended for *personal use in the home or office*. One of ordinary skill in the art would simply not consider the *advertising display device* of Wehr a personal computer, as recited in the instant claims. Applicant also believes that an English translation of the Wehr reference will further support this distinction between the *advertising display device* of Wehr and a personal computer, as recited in the instant claims.

In view of the foregoing omitted claim feature, Applicant respectfully asserts that independent claims 21, 37, and 46 and their respective dependent claims 22-36, 38-45 and 47-50 are patentable over the Wehr reference. Reconsideration and allowance of claims 21-50 are respectfully requested.

II. Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-50 under 35 U.S.C. § 103(a) as being unpatentable over various reference combinations. As discussed below, Applicant respectfully asserts that claims 1-50, as amended, are patentable over the cited references.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Indeed, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir 1988). In other words, the artisan, viewing only the collective teachings of the references, must find it obvious to selectively pick and choose various elements and/or concepts from the cited references to arrive at the claimed invention. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I 1985). Moreover, the Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one employ such hindsight. *See id.*

a. First Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 19, 33 and 43 under 35 U.S.C. § 103(a) as being unpatentable over the Wehr reference in view of the

Lochridge reference (U.S. Pat. No. 5,610,798). Claims 19, 33 and 43 are each dependent on one of independent claims 1, 21 and 37, respectively. In view of the above case law, Applicant respectfully asserts that the foregoing Wehr-Lochridge reference combination is improper due to the lack of the requisite suggestion or motivation to combine the references.

Each of the independent claims, as amended, recites *a personal computer* configured for or having an *integrated display*. Specifically, amended independent claims 1, 21 and 37 recite as follows:

Claim 1: "a personal computer having a
housing configured for a display;"

Claim 21: "a personal computer, comprising: a
housing comprising a display;" and

Claim 37: "a personal computer having a
computer enclosure, comprising: *a display screen.*"

Applicant stresses that the requisite suggestion or motivation to combine is missing and, therefore, the reference combination is improper. As discussed above, the Wehr reference merely discloses an advertising display device and not a personal computer. The Lochridge reference discloses a computer (CPU) that is *divorced* from its display. See Lochridge, column 5, lines 40-42 (stating that "[t]he monitor for the personal computer will generally be located in the middle section 38 of the shelf" of a work station desk 32). Accordingly, the Lochridge reference *teaches against* combining the computer housing with a display. Indeed, the Lochridge reference states that "[a]s

personal computers evolved, it became apparent that it would be *advantageous to separate the keyboard and the monitor from the box housing the central processing unit, motherboard, disk drives and power supply.*" *Id.*, column 1, lines 64-67; column 2, line 1. The Lochridge reference goes on to state that "[t]his increased the flexibility of the personal computers by permitting the use of *different monitors and keyboards.*" *Id.*, column 1, lines 1-3. By *divorcing* the monitor from the CPU housing, the Lochridge reference *teaches away* from a combined display and housing structure, as set forth in the instant claims.

For these reasons, the reference combination is improper and cannot be maintained. Accordingly, Applicant respectfully asserts that claims 19, 33 and 43 are patentable. Reconsideration and allowance of these rejected claims are respectfully requested.

b. Second Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-50 under 35 U.S.C. § 103(a) as being unpatentable over the Goodrich et al. reference (U.S. Pat. No. 5,375,076) in view of the Wehr reference. Again, Applicant respectfully asserts that the foregoing Goodrich-Wehr reference combination is improper due to the lack of the requisite suggestion or motivation to combine the references.

Each of the independent claims, as amended, recites a *personal computer* configured for or having an *integrated display*, wherein the personal computer is *wall mountable*. Specifically, the amended independent claims 1, 21, 37 and 46 recite as follows:

Claim 1: "*a personal computer...[as well as] a wall mount structure* configured to mount the housing on a substantially vertical surface;"

Claim 21: "*a personal computer, comprising...a wall mount assembly* configured to mount the housing to a substantially upright surface;"

Claim 37: "*a personal computer...comprising...a surface mount* configured to mount the computer enclosure to a wall;" and

Claim 46: "integrating a display assembly with a plurality of computing components in a panel enclosure, thereby forming *a personal computer...and coupling a vertical surface mount* to the panel enclosure."

Applicant stresses that the requisite suggestion or motivation to combine the references is missing and, therefore, the reference combination is improper. As discussed above, the Wehr reference merely discloses an *advertising display device* and not a *personal computer*, as recited in each of the above-listed independent claims. The Goodrich reference discloses a "computer system that functions as a *notepad* computer and includes provisions for receiving and storing a keyboard to operate as a *notebook* computer." Goodrich, column 1, lines 7-11. Accordingly, the *portable notepad or notebook computer* of the Goodrich reference is antithetical to the *wall mount or surface mount* personal computer as recited in the instant claims. Indeed, the portable nature of

the Goodrich *notebook computer* teaches away from the *wall mount* structure recited by the instant claims.

Additionally, with reference to the present rejection, the Examiner stated that “[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to supplement said display of Goodrich with the mount structure as taught by DE/29,616,175 [the Wehr reference] in order to facilitate mounting of the display of Goodrich on the vertical surface in order to save [sic] the space on a working surface.” Paper No. 10, page 4. The Examiner apparently believes that the combination or modification is “well-known” to those of ordinary skill in the art. Thus, to the extent the Examiner’s statement may be taken as Official Notice, Applicant seasonably traverses the Examiner’s use of Official Notice, in accordance with M.P.E.P. § 2144.03.

Because the Goodrich-Wehr reference combination lacks the requisite motivation or suggestion to combine the references to reach the instant claims, Applicant respectfully asserts that each of the independent claims and their respective dependent claims are patentable over the Goodrich-Wehr reference combination. Reconsideration and allowance of claims 1-50 are respectfully requested.

c. Patentable Weight of Functional Language

Prior to addressing the next obviousness rejection, Applicant addresses the Examiner's interpretation of claim construction below. In the Office Action, more particularly in reference to the rejection of dependent claims 35 and 45 under the Wehr-Lochridge reference combination, the Examiner stated:

Regarding the functional recitation "wall mountable", please note that it is narrative in form, since any thing [sic] can be mounted to the wall. In order to be given a proper patentable weight, a functional recitation must be expressed as a "means" for performing the specified function (i.e. a specific structure which would allow the device to be readily mounted to the wall), as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claims of sufficient structure to warrant the presence of functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Paper No. 10, p. 6. (Emphasis in original.) Applicant does not agree with the Examiner's interpretation of long standing precedent and black-letter law.

The rules of claim interpretation suggested by the Examiner are incorrect for several reasons. First, the functional limitations recited in the claims are to be given patentable weight. Second, to be given patentable weight, a functional recitation *does not* have to be expressed as a "means" for performing the specified function. Third, a functional limitation *does not* have to "be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language."

First, the Examiner's assertion that "wall mountable" is a functional recitation, and, as such, is not given patentable weight because it is "narrative in form" was improper. Applicant respectfully requests that the Examiner define "narrative in form" and provide the *legal basis* for not giving the allegedly functional limitation patentable weight because of such "narrative" status.

Although the Examiner cited the *In re Fuller* decision (a case decided in 1929), a review of this case fails to show support for the Examiner's position. The *In re Fuller* case revolved around an invention that "consists of a *process* for constructing a woolen fabric for clothing which will have all the advantages of the ordinary woolen fabric yet will not become unduly shiny or glossy as a result of friction and wear." *In re Fuller*, 35 F.2d 62 (C.C.P.A. 1929). (Emphasis added). The focus of the court in *In re Fuller* was the lack of *written description* and a failure to adequately support the claimed invention, which related to a *process*. The only statement Applicant found in this case regarding functional language is a cursory statement that "[i]t [the rejected claim] is also *functional*, describing a result only, and not a *process*, and can, therefore, have no standing here." *Id.* (Emphasis added). In view of the foregoing passage, the *In re Fuller* case appears to be limited to process claims describing a result and, as such, the case does not provide legal basis for ignoring the recitation of "wall mountable," as set forth in the instant claims.

The only other support the Examiner provided for his assertion regarding the patentable weight of "wall mountable" was his statement that "it [the claim recitation] is

narrative in form, since any thing [sic] can be mounted to the wall.” Applicant respectfully asserts that such an interpretation is unreasonable and contrary to what one of ordinary skill in the art would believe. *Cf.* M.P.E.P. § 2173.05(g) (stating that “a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used”). Clearly, the term wall mountable in combination with the specific structures recited in the instant claims would fairly convey wall-mounting mechanisms for the respective structures. Accordingly, the recitation “wall mountable” should undoubtedly be given patentable weight.

Secondly, to be given patentable weight, a functional recitation *does not* have to be expressed as a “means” for performing the specified function, particularly where the claims are not intended to fall within the scope of 35 U.S.C § 112, sixth paragraph. The instant claims are not intended to be “means for” claims and, as such, Section 112, sixth paragraph, is inapplicable to the instant claims.

Thirdly, a functional limitation *does not* have to “be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language,” as asserted by the Examiner. The M.P.E.P. § 2173.05(g) specifically states that:

There is *nothing inherently wrong* with defining some part of an invention in *functional terms*. . . . A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in

the context in which it is used.... A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is recited by the element, ingredient or step.

M.P.E.P. § 2173.05(g). (Emphasis added). Indeed, courts have recognized that there may be a practical *necessity* for the use of functional language. *See In re Swinehart*, 439 F.2d 210, 213, 169 U.S.P.Q. 226, 228-29 (C.C.P.A. 1971). (Emphasis added). Under the view today, functional language in a claim is not objectionable *per se* so long as it avoids problems of undue breadth and vagueness. *See Donald S. Chisim, CHISIM ON PATENTS* § 8.04, p. 8-99 (citing *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226). What is important is *not* simply that a recitation is defined in terms of what it does, but that the recitation has a reasonably well-understood meaning in the art. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1996) (further stating that “many devices take their names from the functions they perform.... [and that] ‘Detent’ (or its equivalent ‘detent mechanism’) is just such a term”). In other words, so long as a recitation is readily understood by those in the pertinent art (i.e. it is not vague and unduly broad), it must be given patentable weight.

As discussed above, the recitation “wall mountable” is a term that would be readily understood and appreciated by one of ordinary skill in the art of computers. For the reasons set forth above, the recitation “wall mountable” must be given patentable weight.

c. Third Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 19, 33 and 43 under 35 U.S.C. § 103 as being unpatentable over the Goodrich reference in view of the Wehr reference and in further view of the Lochridge reference. Claims 19, 33 and 43 are dependent claims that depend from claims 1, 21 and 37, respectively. In light of the following remarks, Applicant respectfully asserts that the rejected dependent claims are patentable over the Goodrich-Wehr-Lochridge reference combination.

As discussed above, each of the above-referenced independent claims (i.e. claims 1, 21 and 37) recite *a personal computer* configured for or having an *integrated display* that is *wall mountable*. Specifically, the amended independent claims 1, 21 and 37 recite as follows:

Claim 1: "*a personal computer* having a housing configured for *a display*...[as well as] *a wall mount structure* configured to mount the housing on a substantially vertical surface;"

Claim 21: "*a personal computer*, comprising: a housing comprising *a display*...[and] *a wall mount assembly* configured to mount the housing to a substantially upright surface;" and

Claim 37: "*a personal computer*...comprising...*a display screen* ...and a *surface mount* configured to mount the computer enclosure to a wall."

Applicant stresses that the Wehr-Goodrich-Lochridge reference combination lacks the requisite motivation or suggestion to combine the respective references and, therefore,

the reference combination is improper. As discussed above, the Wehr reference does not disclose a *personal computer*, but rather discloses an *advertising display device*.

Furthermore, the remaining references of the above-referenced combination (i.e., the Goodrich reference and the Lochridge reference) teach away from the recitations of the instant claims. The Lochridge reference explicitly *teaches away* from integrating a display with the computer body. *See Lochridge*, column 1, lines 64-66; column 2, lines 1-3. Indeed, the reference extols the advantages of separating the box (i.e. the housing containing the CPU and other computer components) from the keyboard and monitor, and, as such, teaches away from the recitations of the instant claims. *See id.*

Furthermore, the Goodrich reference teaches a *notebook* computer that is *portable* in nature. *See Goodrich*, column 1, lines 29-32. As such, the Goodrich reference teaches away from the instant claims, which, in a general sense, recite a wall mountable personal computer.


Because the cited reference combination lacks the requisite motivation or suggestion to combine the references, Applicant respectfully asserts that claims 19, 37 and 43 are patentable over the Wehr-Goodrich-Lochridge reference combination. Reconsideration and allowance of the present claims are respectfully requested.

Conclusion

In view of the above remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Date: 9/11/03

Respectfully submitted,



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